

## REMARKS

The Office Action mailed January 24, 2005 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-5, 7-9, 11-24, 26-28, 30, and 31 are pending in this application. Claims 1-11, 21-24, 26-28, 30, and 31 stand rejected. Claims 12-20 have been allowed.

The rejection of Claims 21-24, 26-28, 30, and 31 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is respectfully traversed. More specifically, Claim 21 has been amended to delete “during said check run” from the recitation of “means for determining the weight of contaminants filtered in said first filter.” Accordingly, Applicant respectfully submits that Claim 21, as amended, satisfies the requirements of Section 112, first paragraph. Claims 22-24, 26-28, 30, and 31 depend, directly or indirectly, from independent Claim 21. When the recitations of Claims 22-24, 26-28, 30, and 31 are considered in combination with the recitations of Claim 21, Applicant respectfully submits that Claims 22-24, 26-28, 30, and 31 likewise satisfy the requirements of Section 112, first paragraph. For at least the reasons set forth above, Applicants respectfully request that the Section 112, first paragraph, rejection of Claims 21-24, 26-28, 30, and 31 be withdrawn.

The rejection of Claims 2-5 under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is respectfully traversed. More specifically, Claim 2 has been amended to recite “soaking said primary filter in a solvent prior to said step of (d) weighing said primary filter to determine the weight of contaminants collected in said primary filter.” Accordingly, Applicant respectfully submits that Claim 2, as amended, satisfies the requirements of Section 112, second paragraph. Claim 3 depends from independent Claim 2. When the recitations of Claim 3 are considered in combination with the recitations of Claim 2, Applicant respectfully submits that Claim 3 likewise satisfies the requirements of Section 112, second. Additionally, Claim 4 has been amended to recite “soaking said primary filter

in a first solvent and then soaking said primary filter in a second solvent prior to said step of (d) weighing said primary filter to determine the weight of contaminants collected in said primary filter.” Accordingly, Applicant respectfully submits that Claim 4, as amended, satisfies the requirements of Section 112, second paragraph. Claim 5 depends from independent Claim 4. When the recitations of Claim 5 are considered in combination with the recitations of Claim 4, Applicant respectfully submits that Claim 5 likewise satisfies the requirements of Section 112, second paragraph. For at least the reasons set forth above, Applicants respectfully request that the Section 112, second paragraph, rejection of Claims 2-5 be withdrawn.

The rejection of Claims 1 and 7-9, and 11 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,457,564 (Damm) in view of Jap. Pat. No. JP10170504A (Sakai) is respectfully traversed.

Damm describes a lubrication system for supplying a lubricant to one or more gear driven devices, whether or not the gear driven devices are in operation or not. Accordingly, Damm describes an engine (2) that is coupled to a gear device (3). The engine includes a lubricant pump (6) that causes a lubricant (L) to flow from a lubricant sump (5) through an external lubricant line (7) that includes a filter (8). Damm also describes that the gear device (3) includes a return line (23) including a filter (24) for filtering the lubricant before re-entering the engine. Notably, Damm does not describe nor suggest a system for performing a clean check on a gearbox after final assembly wherein the filters are weighed to determine a weight of contaminant in the filter and determining whether the gear box is acceptable for use by comparing the contaminant weight to a predetermined level.

Sakai, to the extent understood, describes a measuring apparatus that quantitatively determines the amount of a contaminant that has been dissolved in a refrigerant oil. In use, the system is evacuated and the refrigerant oil is poured into a sample container (11). A mixed solution of refrigerant and refrigerant oil is passed through a filter inside a filter holder (12). Based on the change in weight of the filter assembly, the amount of contaminant

precipitated in the mixed solution can be evaluated. Notably, Sakai does not describe nor suggest performing a clean check on the system to determine cleanliness after final assembly. Rather, Sakai describes a measuring apparatus that quantitatively determines an amount of a contaminant dissolved in refrigerator oil of an apparatus, after the apparatus has been operated for an extended period of time.

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of Damm nor Sakai, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicant respectfully submits that it would not be obvious to one skilled in the art to combine Damm with Sakai, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicant's own teaching. Rather, only the conclusory statement that “[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the oil quality determining method as disclosed by Damm et al. with the contaminants weight determining method as taught by Sakai et al. in order to provide a more accurate and convenient way of measuring, as described in the Abstract of Sakai et al., so that the system is provided with longer life.”

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levingood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is clearly based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention.

Moreover, if art “teaches away” from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited, as a whole, is not suggestive of the presently claimed invention. Moreover, Applicant submits that Damm teach away from Sakai and the present invention, and as such, there is no suggestion or motivation to combine Damm with Sakai. Specifically, Damm describes an engine coupled to a gear device that pumps oil through a filter on a lubricant line, and Sakai describes an apparatus that quantitatively evaluates a contaminant dissolved in a refrigerant oil. Accordingly, for at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection be withdrawn.

Moreover, to the extent understood, no combination of Damm and Sakai describes or suggests the claimed combination and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claim 1 recites a method of performing a clean check on a gearbox after final assembly, wherein the method includes “(a) filtering an oil-based fluid in a preliminary filter... (b) weighing a primary filter... (c) flushing said oil-based fluid through said gearbox and then through said primary filter... (d) weighing said primary filter to determine the weight of contaminants collected in said primary filter... (e) determining whether said gearbox is acceptable for use by comparing said contaminant weight to a predetermined level, wherein said gearbox is acceptable for use if

said contaminant weight is below said predetermined level...and (f) repeating steps (a)-(e) if said contaminant weight is above said predetermined level.”

Neither Damm nor Sakai, considered alone or in combination, describe or suggest each of the recitations of Claim 1. Specifically, neither Damm nor Sakai describe or suggest determining whether a gearbox is acceptable for use by comparing a contaminant weight to a predetermined level, wherein the gearbox is acceptable for use if the contaminant weight is below the predetermined level. Rather, Damm describes an engine coupled to a gear device that pumps oil through a filter on a lubricant line, and Sakai describes an apparatus that quantitatively evaluates a contaminant dissolved in a refrigerant oil. Accordingly, and for at least the reasons set forth above, Claim 1 is submitted as patentable over Damm in view of Sakai.

Applicant respectfully disagrees with the assertion within the Office Action, at page 4, that Sakai et al. describe “comparing the contaminant weight to a predetermined level, wherein the apparatus is acceptable if the contaminant weight is below the predetermined level.” Rather, Sakai et al. merely describe that the amount of contaminant precipitated in a mixed solution can be determined based on the change in weight of the filter assembly. Sakai et al. therefore does not describe nor suggest determining whether a gearbox is acceptable for use by comparing a contaminant weight to a predetermined level to determine if the contaminant weight is below the predetermined level. Moreover Sakai do not describe nor suggest a filter-based system that is used during the assembly process to determine the cleanliness of the system. Rather, in contrast to the present invention, Sakai describes that the contaminated filter weight is compared to a non-contaminated filter weight to determine the quantity of contaminants precipitated in the refrigerant oil.

Moreover, Applicant respectfully submits that determining whether a gearbox is acceptable for use by comparing a contaminant weight to a predetermined level, wherein the gearbox is acceptable for use if the contaminant weight is below the predetermined level, as recited in Claim 1, is not inherently shown by Sakai. Specifically, “[i]n relying upon the

theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In re King, 231 USPQ 136 (Fed. Cir. 1986). The examiner has not provided any basis in fact and/or technical reasoning that the systems or methods taught by Damm et al. or Sakai et al. include a step of “determining whether a gearbox is acceptable for use by comparing a contaminant weight to a predetermined level, wherein the gearbox is acceptable for use if the contaminant weight is below the predetermined level.” Rather, on page 9 of the Office Action the Examiner merely states that “the inherent purpose of measurement is to ‘compare,’” and “[i]f there is no ‘predetermined value’ to compare the measurement with, then the purpose of the measuring apparatus would be meaningless and worthless.”

The Examiner further states on page 9 that “[e]ither improvements or simple maintenance requires some sort of predetermined value (preferably determined by the designer) to compare the new and old values so that one of ordinary skill in the art may know what is the acceptable contaminant level.” However, Applicant respectfully submits that the contaminant measurements of Sakai can have a value without determining whether an apparatus using the refrigeration oil described in Sakai is acceptable for use by comparing the measurements to a predetermined value. For example, such measurements of Sakai may be used to determine a quality of the refrigeration oil rather than an acceptability of an apparatus using the oil. Applicant maintains that determining the quality of a lubricant is not analogous to the determining step recited in Claim 1.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claim 1 be withdrawn.

Claims 7-9 and 11 depend from independent Claim 1. When the recitations of Claims 7-9 and 11 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 7-9 and 11 likewise are patentable over Damm in view of Sakai.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1, 7-9, and 11 be withdrawn.

The rejection of Claims 2-5 under 35 U.S.C. 103(a) as being unpatentable over Damm in view of Sakai and further in view of Jap. Pat. No. JP10170504A (Kodaira) is respectfully traversed.

Damm and Sakai are described above. Kodaira, to the extent understood, describes a method of determining a quantity of machining oil remaining on the surface of a metal product cleaned with a cleaner. The method includes inserting the metal product into a cleaning tank containing a solvent, dissolving the machining oil using the solvent, extracting the mixture of cleaning oil and solvent through a filter, and measuring the quantity of cleaning oil using a concentration meter or an infrared spectrum analysis system.

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of Damm, Sakai, nor Kodaira, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicant respectfully submits that it would not be obvious to one skilled in the art to combine Damm, Sakai and Kodaira, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicant's own teaching. Rather, only the conclusory statement that “[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of performing a clean check on a gearbox of Damm et al. in view of Sakai et al. by adding the step of soaking a device in a solvent prior the step of measuring as taught by Kodaira et al. in order to provide a more accurate means of targeted measurement so that the cost involved in maintenance can be reduced.”

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levingood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is clearly based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention.

Moreover, if art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited, as a whole, is not suggestive of the presently claimed invention. Moreover, Applicant submits that Damm teach away from Sakai and Kodaira and the present invention, and as such, there is no suggestion or motivation to combine Damm with Sakai and Kodaira. Specifically, Damm describe an engine coupled to a gear device that pumps oil through a filter on a lubricant line, Sakai describe an apparatus that quantitatively evaluates a contaminant dissolved in a refrigerant oil, and Kodaira describe measuring the quantity of cleaning oil using a concentration meter or an infrared

spectrum analysis system. Accordingly, for at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection be withdrawn.

Moreover, and to the extent understood, no combination of Damm, Sakai, and/or Kodaira describes or suggests the claimed combination and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claims 2-5 depend from independent Claim 1 which recites a method of performing a clean check on a gearbox after final assembly, wherein the method includes “(a) filtering an oil-based fluid in a preliminary filter... (b) weighing a primary filter... (c) flushing said oil-based fluid through said gearbox and then through said primary filter... (d) weighing said primary filter to determine the weight of contaminants collected in said primary filter... (e) determining whether said gearbox is acceptable for use by comparing said contaminant weight to a predetermined level, wherein said gearbox is acceptable for use if said contaminant weight is below said predetermined level... and (f) repeating steps (a)-(e) if said contaminant weight is above said predetermined level.”

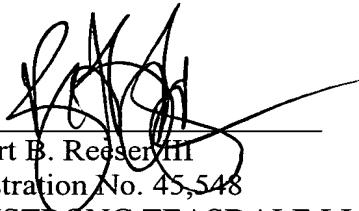
As discussed above, neither Damm nor Sakai, considered alone or in combination, describe or suggest determining whether a gearbox is acceptable for use by comparing a contaminant weight to a predetermined level, wherein the gearbox is acceptable for use if the contaminant weight is below the predetermined level. Kodaira does not make up for the deficiencies of Damm and Sakai, but rather merely describes measuring the quantity of cleaning oil using a concentration meter or an infrared spectrum analysis system. Accordingly, and for at least the reasons set forth above, Claim 1 is submitted as patentable over Damm in view of Sakai and further in view of Kodaira.

Claims 2-5 depend from independent Claim 1. When the recitations of Claims 2-5 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-5 likewise are patentable over Damm in view of Sakai and further in view of Kodaira.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 2-5 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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